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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Applicant: Vakharia)	Art Unit: 3781
)	
Serial No.: 10/622,006)	Examiner: Mai
)	
Filed: July 17, 2003)	Docket No: T0095US
)	
For: HEAD COVER FOR A GOLF CLUB)	November 21, 2007
)	750 B STREET, Suite 3120
)	San Diego, CA 92101
)	

REPLY BRIEF

Commissioner of Patents and Trademarks

Dear Sir:

This responds to the Examiner's Answer dated November 14, 2007.

Added Grounds of Rejection

Appellant notes that the previous rejections based on Rosenow in view of Russell or Kurt and on Lauretti in view of Russell or Kurt have each been bifurcated into rejections based on each secondary reference individually, for the purpose of removing Claim 5 from rejections based on Russell but not on Kurt. While the conferees do not put it exactly this way, Appellant agrees that the need for the approval of the Technical Center Director for these added rejections is obviated because the basic thrust of the rejections remains the same, the statutory basis remains the same, and the evidence relied on remains the same, see MPEP §1207.03(III), rendering the case ripe for review by the Board.

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CENTRAL FAX CENTER**NOV 21 2007****CASE NO.: T0095US**
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Filed: July 17, 2003**Flaws in Answer Related to Continued Application of Non-Analogous Art****Kurt Reference**

The bottom of page 9 of the Answer illustrates the logical flaw in the rejections that continues to bedevil prosecution. Specifically, in discussing why the baby clothes patent to Russell and the clothing patent to Kurt (which also mentions non-clothing applications but, conspicuously, nothing in the field of golf or for that matter any sport) are analogous to claims that explicitly recite "golf club head cover", the conferees conclude, without any evidence of record, that both references are "pertinent" to solving "the same problem as discussed in this application" when in fact neither reference has anything to do with covering a golf club head. Indeed, the ensuing quote from Kurt on the top of page 10 of the Office Action in fact underscores the flaw.

First, the quote lifted out of Kurt regarding objects of the Kurt invention is untethered from the teachings of the reference as a whole, which do not mention sports, much less golf, much less golf club head covers. Simply mentioning generalized objects without considering the applications envisioned by a reference leads to eviscerating the requirement of basing obviousness rejections on analogous art, since almost every patent mentions its generalized advantages - and this is precisely why MPEP §2141.02 requires consideration of the reference as a whole in determining analogousness.

Second, and as if to make the point that the reference as a whole must be considered, the objects of Kurt quoted on page 10 of the Answer in fact are irrelevant if not contradictory to application as a golf club head cover. For instance, the "principal" object of providing a closure which "cannot jam or become inoperative by engaging foreign material between the elements thereof" has not been shown to be relevant to golf club head covers and indeed one would not expect it to. Unlike Kurt's envisioned applications, putting

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a zippered head cover on a golf club does not raise the specter of jamming due to foreign material, since the club is a rigid object with no moving parts or non-rigid constituents that might possibly intrude between the zipper elements. In any case, no evidence of record has been adduced showing that this particular problem of Kurt is faced in golf club head cover design.

Consider also Kurt's statement quoted in the Answer of the problem of tension forces across the opening, presumably referring to a stuffed piece of clothing or bag that is difficult to zipper. Because a golf club head is rigid and non-expanding, this part of Kurt does not appear to be of relevance to the head cover designer.

The third object of Kurt mentioned in the Answer - to provide an easy opening and closing fastener - is nice but again, without evidence showing that zippered golf club head covers posed cumbersome and awkward challenges to golfers, and without considering the remainder of Kurt to understand why Kurt is focused on this object, this "object" fails to show that Kurt is analogous to golf club head covers.

The same is true of the fourth object mentioned on the top of page 10 of the Answer. Absent evidence of record that zippered golf club head covers are not sufficiently strong, the stated object bears no relevance to the present claims. In fact, that zippers are weaker than magnetized closures is a proposition that in and of itself has not been demonstrated using evidence of record.

The last object of Kurt mentioned in the Answer may be the most questionable if that were possible, because absolutely no evidence of record has been adduced that zippers, staples of commerce if ever there was one, are more expensive and more complex to make than magnetized closures, much less that a need existed in the golf club head cover art to find a cheaper substitute for zippers.

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Page 10 of the Answer alleges that because Kurt uses the word "cover", it is "pertinent art in the rejection." But this is just a rehash of the error noted throughout prosecution, namely, that a single isolated word of Kurt is being plucked from the reference without reference to the rest of Kurt and thus without understanding what the teaching means. In Kurt's case, there is nothing whatsoever in the reference that remotely suggests that Kurt motivates use for golf club head covers; indeed, as the above analysis of the objects of Kurt demonstrates, quite the opposite.

Incomplete and Legally Insupportable Reliance on KSR

The top of page 11 of the Answer reflect clear legal error, alleging that even if Kurt is not "pertinent", it may still be used under KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727 (2007). This is a legal conclusion unsupported by KSR and in fact contradicted by it.

KSR had nothing to do with the issue of analogousness, much less that it was overriding any previous legal guidance related to the principle. In fact, KSR repeatedly invokes *relevant* prior art, e.g., slip op., page 8, second and seventh sentences under part (I)(C) of the opinion and first sentence of part (III). Indeed, KSR affirmed the underlying principles of Graham v. John Deere Co. of Kansas City, 383 U.S. 1 (1966), slip op., page 11, part (II)(A), which would include the existing principles of analogousness discussed in Appellant's Appeal Brief and repeatedly ignored during prosecution.

Proper Application of KSR Militates Toward Reversal

As was the case with the approach of the Answer in analyzing Kurt piecemeal and in failing to recognize that the parts of Kurt being relied on in fact buttress Appellant's position, the Answer incompletely

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and incorrectly applies KSR to the present case and in fact presents a part of KSR that militates toward patentability. More specifically, as admitted by the conferees on page 11 of the Answer, KSR clarifies that variations of a work in the same field or a different one can be prompted by design incentives and other market forces "[i]f a person of ordinary skill can implement *a predictable variation*...if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve *similar devices* in the same way, using the technique is obvious unless its actual application is beyond his or her skill" (emphasis mine). This statement thus clarifies that "variations in a different field" can be suggested *if* they are predictable or implemented on "similar" devices, which in fact is a differently stated way of saying "if they are analogous."

KSR carefully explains, following the above guidance on page 13 of the slip opinion, that "a court must ask whether the improvement is more than the *predictable* use of prior art elements according to *their established functions*" (emphasis mine). In the present case, no evidence has been adduced of record that the relied-upon clothing magnetic fasteners had, as "established functions", closing the slit of a cover for a rigid athletic tool, much less for a golf club head cover. And this latter comment is particularly germane in the KSR framework: "[i]n determining whether the subject matter of a patent claim is obvious, neither the particular motivation nor the avowed purpose of the patentee controls. *What matters is the objective reach of the claim*" slip op., page 16 (emphasis mine). Here, all claims are explicitly limited to golf club head covers, not to "closures" or to some other generalized, opaquely defined "cover".

Finally, unlike the present case of obviousness, which relies on unsupported conclusions by Patent Office personnel that non-sports references are "pertinent" to golf club head covers, the Court in KSR emphasized that its decision was underpinned by actual evidence: "KSR provided convincing evidence" of its

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position, last paragraph of opinion. Indeed, since KSR issued, the CAFC has explicitly held that it is error for the Board to sustain an obviousness rejection based on its own expertise unsupported by further evidence, Brand v. Miller, no. 2006-1419 (CAFC precedential case issued in May 2007). The principles of KSR properly understood within the context of the case thus militate toward reversal.

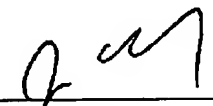
Russell Reference

The defects in the Answer's rationale regarding why Russell is analogous are substantially the same as those discussed above.

Declarations Must be Considered

The declarations have been dismissed by the conferees but remain of record. Appellant disagrees with the analysis and conclusions of the conferees in this regard and notes that the Board should consider this evidence, In re Sullivan, no. 2006-1507 (precedential CAFC opinion issued in November 2007).

Respectfully submitted,



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